

Remarks

Status of the Claims

1. The Office rejected Claim 1-15 under 35 U.S.C. 102(b) as anticipated by U.S. Patent 6,054,989 (*Robertson*).
2. The Office rejected the terminal disclaimer "filed 3/16/2004", asserting that a fee under 37CFR1.20(d) was due and not paid. The Office Action did not explicitly repeat the nonstatutory obviousness-type double patenting over claims 1 and 5 of U.S. patent 6,724,400 that prompted the terminal disclaimer (actually filed 1/31/2007).
3. Applicant has amended Claim 5 to correct a minor typographical error.

Rejection of Claims 1-15 under 35 U.S.C. 102(b) as anticipated by *Robertson*

4. For a reference to anticipate a **claim**, the reference must teach **every** element of the **claim, in as complete detail** as is contained in the **claim**. See, e.g., MPEP 2131; *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Because *Robertson* does not teach or suggest every limitation of **Claims 1-15**, Applicant submits that there is no *prima facie* case of anticipation by *Robertson*. As argued previously, *Robertson* does not teach any interaction with a **device** moveable in **three** dimensions, or changing of interface characteristics based on motion of a **device** in the z-dimension of the device's range of motion.
5. The Office, in the present Office Action, repeated previous rejections based on *Robertson*, asserting that "applicant's specification discloses an input device that is able to navigate in a three-dimensional space or plane. From the applicant's specification this does not make the input device itself three-dimensional only the area on the display screen." Applicant suggests that the Office's assertion mischaracterizes both applicant's specification and the application of the requirements for a reference to anticipate a claim.
6. While the Office is correct in the assertion that Applicant's specification does not **require** a three-dimensional input device, it should be noted that Applicant's specification has various descriptions of input devices moveable in more than two dimensions. As examples: page 2 lines 7-9 (describing the need for the present invention to exploit the capabilities of six degree of freedom input devices); page 7 lines 14-15 (describing the use of a three-dimensional input device when in an application domain); Figs. 9 and 10 (showing a three-dimensional space in

which an input device can be moved); page 14 lines 22-24 (describing the input device of Fig. 9 as moveable in three dimensions); page 15 lines 1-14 (showing portions of a device's three-dimensional range of motion mapped to domain boundaries).

7. Even if Applicant's **specification** does not require that the input device be moveable in three dimensions, rejections under 35 U.S.C. 102 are applied to the **claims** and not the **specification**. Applicant's **claims**, as originally filed and as clarified in the previously entered amendment, are limited to input devices moveable in three-dimensions. Claim 1 is limited to a method "using an input device having a range of motion in three dimensions". Claim 2 is limited to "using an input device having a range of motion in three dimensions". The claims name the axes of the input device's three dimensions of allowable motion "x-device", "y-device", and "z-device" to avoid confusion with three dimensions of the display space ("x-display", "y-display", and "z-display"). Various of the claims depending from Claim 2 are further limited to specific determinations based on the motion of the **three-dimensional input device** in the three "___-device" dimensions. Accordingly, all of the rejected **claims** are limited to devices moveable in three dimensions. As discussed before, and not controverted by the Office, *Robertson* is concerned only with two-dimensional input devices, and has no teaching or suggestion of an input device moveable in three dimensions. Accordingly, there can be no anticipation of the **claims** based upon *Robertson*. Applicant submits that Claims 1-15 are in condition for allowance.

8. Selection between application and personal domains by device motion in the z dimension. Claim 2 is further limited to a method that selects between two distinct domains (and consequently which interface characteristics to provide), based on motion of a **device** in a z dimension of a three-dimensional input device's range of motion. *Robertson* teaches selection of **objects by mouse clicks**, but not selection between **interface domains by input device motion** in the z dimension of the input device's range of motion. In Applicant's Claim 2, the active interface domain is determined by motion of an input device in the z dimension of the input device's range of motion. *Robertson* mentions a z dimension only as an aspect of the simulated space, and only for organizing objects, and even then describes Workspace (background art, not *Robertson*'s invention) where pushing and pulling documents in the Z dimension "will be cumbersome for users in practice." *Robertson* col 5 lines 65. Further, *Robertson*'s only teaching of three-dimensional input is when mapping **two-dimensional** input device motion to a simulated three-dimensional space, and thus could not select an interface domain based on motion of an input device in the z dimension of the **input device's** range of

motion. Because *Robertson* does not teach selection between two distinct interface domains based on movement of an **input device** in the z dimension of the input device's range of motion, *Robertson* does not anticipate Claim 2 or Claims 3-15 depending therefrom. Applicant submits that Claims 2-15 are in condition for allowance.

Acceptance of the Terminal Disclaimer filed 1/31/2007

9. Applicant filed a terminal disclaimer on 1/31/2007 (the Office Action erroneously referred to a termination disclaimer filed on "03/16/2004", the filing date of the application itself). The Office Action indicated that the terminal disclaimer was not accepted since a disclaimer fee under 37 CFR 1.20(d) was due and had not been paid. Applicant submits that no fee is required, and requests reconsideration of the terminal disclaimer.

10. The terminal disclaimer was filed under 37 CFR 1.321(c), to obviate a rejection based on the judicially created double patenting in a patent application. 37 CFR 1.321(c) is reproduced below in its entirety for convenience:

(c) A terminal disclaimer, when filed to obviate judicially created double patenting in a patent application or in a reexamination proceeding except as provided for in paragraph (d) of this section, must:

- (1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;
- (2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding; and
- (3) Include a provision that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the judicially created double patenting.

11. Disclaimers filed under 37 CFR 1.321(a) and (b) do require a fee, but note that there is no fee requirement for a terminal disclaimer filed under 37 CFR 1.321(c). Accordingly, there was no fee due in connection with the filing of the terminal disclaimer.